

### **REMARKS**

Support for claim amendments and the new claims can be found in the specification at least on pages 18-25. Reconsideration and further examination are respectfully requested.

#### **§ 102 Rejections**

Claims 1-10, 12-18, and 66-68 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by PCT No. WO 00/38074 (Kay).

Claim 10 recites “evaluating current advertisement rankings of the first plurality of advertisements for changes in the advertisement rankings upon receiving the request as compared to the advertisement rankings on which the generation of the advertisement image was based, and if there are changes in the advertisement rankings, generating a modified advertisement image, wherein the modified advertisement image identifies a second plurality of advertisements related to the specific distribution subject including current highest ranking advertisements of the first plurality of advertisements; storing the modified advertisement image in association with the network-based locator; and transmitting one of the advertisement image or the modified advertisement image in response to the request for inclusion in the electronic document.” The Examiner cites page 16, lines 2-5 and Fig. 3A for an alleged teaching of these claim features.

The description associated with Fig. 3A indicates that when a view-op becomes available, its properties are compared to the properties set out in the various bids and the highest matching bid is selected. *See* Page 16. Kay further provides that a determination is made as to whether or not this view-op is needed to meet the schedule set out in the winning bid, if not then the view op is assigned to the next lower matching bid. *See id.* If it is needed to meet the schedule, a check is made to determine if the initialization period is over. *See id.* The relied upon portions of Kay are silent as to any teaching or suggestion of “**evaluating current advertisement rankings . . . for changes in the advertisement rankings upon receiving the request as compared to the advertisement rankings on which the generation of the advertisement image was based,**” as recited in claim 10. The relied upon portions are merely comparing properties of a view-op

when it becomes available and determining if a view-op (an advertisement) meets a schedule. The relied upon portions of Kay do not compare any rankings “for changes in the advertisement rankings” and the relied upon portion do not generate any “modified advertisement image” if there are changes in the rankings. Applicant respectfully asserts that in the relied upon portions of Kay, the view-ops are never ranked. Furthermore, the relied upon portions of Kay do not identify a “second plurality of advertisements . . . based on the changes in the advertisement rankings” and include them in a “modified advertisement image” as recited in claim 10.

Finally claim 1 recites “transmitting one of the advertisement image or the modified advertisement image . . . in response to the request for inclusion in the electronic document.” The Examiner cites Fig. 3B of Kay for an alleged teaching of these claim features. Applicant respectfully disagrees. The text associated with Fig. 3B indicates that the Kay system looks at the results achieved at each site where an advertisement was previously displayed and the results achieved are examined. *See* page 16. In the simplest case it would be the number of “click-throughs” which resulted from the advertisement. *See id.* The selection or scheduling criteria for each site is set based on these numbers. Based on the selection criteria if the view-op should be taken, the advertisement is displayed. *See* page 16-17. Selecting an advertisement based on the bids and click-through rates, however, does not teach or suggest transmitting the “modified advertisement image stored in association with the network-based locator in response to the request for inclusion in the electronic document,” as recited in claim 10. The relied upon portions of Kay not only do not teach a “modified advertisement image” as discussed above, but also do not **transmit any advertisement image for inclusion in an electronic document**. The relied upon portions of Kay are merely selecting one advertisement that is associated with a highest bid.

Applicant respectfully asserts that Kay does not teach or suggest “evaluating current advertisement rankings of the first plurality of advertisements for changes in the advertisement rankings upon receiving the request as compared to the advertisement rankings on which the generation of the advertisement image was based, and if there are changes in the advertisement rankings, generating a modified advertisement image, wherein the modified advertisement image identifies a second plurality of advertisements related to the specific distribution subject including current highest ranking advertisements of the first plurality of advertisements; storing

the modified advertisement image in association with the network-based locator; and transmitting one of the advertisement image or the modified advertisement image in response to the request for inclusion in the electronic document.” Applicant respectfully requests the Examiner withdraw the 102(b) rejection of claim 10. Claims 12-18 depend from claim 10 and are allowable for at least the same reasons set forth above with respect to claim 10.

Claim 1 recites “advertisement image generation means for generating an advertisement image including ranking means for generating advertisement rankings for a first plurality of advertisements related to a specific distribution subject, and storage means for storing a plurality of advertisements including highest ranked advertisements in the first plurality of advertisements where storing includes storing the advertisement image in association with a network-based locator; advertisement image receiving means for receiving a request for the advertisement image associated with the network-based locator for inclusion in an electronic document; advertisement relationship determination means for evaluating current advertisement rankings of the first plurality of advertisements for changes in the advertisement rankings upon receiving the request as compared to the advertisement rankings on which the generation of the advertisement image was based, and if there are changes in the advertisement rankings, initiating the advertisement image generation means to generate a modified advertisement image, wherein the modified advertisement image identifies a second plurality of advertisements related to the specific distribution subject and includes the then highest ranking advertisements, and stores the modified advertisement image in association with the network-based locator; and advertisement image transmission means for transmitting one of the advertisement image or the modified advertisement image in response to the request for inclusion in the electronic document.”

Claim 1 is allowable for at least the same reasons set forth above with respect to claim 10. Claims 2-9 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

#### § 103 Rejections

Claim 69 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kay in view of Official Notice. Claim 70 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kay in view of U.S. Patent No. 6,260,024 (Shkedy).

The Examiner takes Official Notice and states that it is "old and well known for electronic documents to be in the form of e-mail in order to allow recipients to view the electronic information when they please." See Office Action, page 4. Applicant refers the Examiner to MPEP § 2144.03. In relevant part, MPEP § 2144.03 states, "If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and an explanation to support the finding." Applicant submits that the Examiner has made a generalized statement citing "for documents to be in the form of e-mail" without any documentary evidence to support it. Applicant traverses the Examiner's taking of "Official Notice," noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *See id.* Applicant submits that "[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is 'basic knowledge' or 'common sense.'" In re Lee, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicant submits that the Examiner must provide "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." In re Soli, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963). Therefore, Applicant respectfully requests the Examiner withdraw the 35 U.S.C. § 103 rejection of claim 69.

Claim 69 depends, indirectly, from claim 1 and is allowable for at least the same reasons set forth above with respect to claim 1. Claim 70 has been cancelled rendering this rejection moot.

New claim 71 recites "generating advertisement rankings for a first plurality of advertisements related to a specific distribution subject; generating an advertisement image including a plurality of advertisements including highest ranked advertisements; storing the advertisement image in association with a network-based locator; receiving a request for the advertisement image associated with the network-based locator for inclusion in an electronic document; evaluating current advertisement rankings of the first plurality of advertisements for

changes in the advertisement rankings upon receiving the request, and if there are changes in the advertisement rankings, generating a modified advertisement image, wherein the modified advertisement image identifies a second plurality of advertisements related to the specific distribution subject and includes a plurality of advertisements including current highest ranking advertisements, storing the modified advertisement image in association with the network-based locator; and transmitting one of the advertisement image or the modified advertisement image in response to the request for inclusion in the electronic document.”

Claim 71 is allowable for at least the same reasons set forth above with respect to claim 10.

Claim 72 recites “generating advertisement rankings for a first plurality of advertisements related to a specific distribution subject; generating an advertisement image including at least two highest ranked advertisements; storing the advertisement image in association with a network-based locator; receiving a request for the advertisement image associated with the network-based locator for inclusion in an electronic document; evaluating current advertisement rankings of the first plurality of advertisements for changes in the advertisement rankings upon receiving the request, and if there are changes in the advertisement rankings, generating a modified advertisement image including at least two then current highest ranked advertisements; storing the modified advertisement image in association with the network-based locator; and transmitting one of the advertisement image or the modified advertisement image in response to the request for inclusion in the electronic document.”

Claim 72 is allowable for at least the same reasons set forth above with respect to claim 10.

Claim 73 recites “identifying a plurality of advertisements associated with a distribution subject; ranking the plurality of advertisements; storing at least one as a highest ranked advertisement, the storing including associating the highest ranking advertisement with a network-based locator; receiving a request for the advertisement associated with the network-based locator for inclusion in an electronic document; re-ranking the plurality of advertisements; storing a second advertisement as the highest ranking ad if rankings of the plurality of advertisements have changed, the storing including associating the second advertisement with

the network based locator; and transmitting the highest ranking advertisement in response to the request.”

Claim 73 is allowable for at least the same reasons set forth above with respect to claim 10.

Conclusion

By responding in the foregoing remarks only to particular positions taken by the examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

The Applicant respectfully requests that all pending claims be allowed. Please apply any charges not otherwise paid, or apply any credits to deposit account 06-1050.

Respectfully submitted,

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